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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/825,790   | 04/16/2004  | Wen-Jiunn Tsay       | N0134/PP/HH         | 9070             |
| 41744  | 7590        | 08/24/2004           | EXAMINER            |                  |
| TRANSPACIFIC LAW GROUP<br>617 NORTH DELAWARE STREET<br>SAN MATEO, CA 94401 |             |                      | LE, THANH TAM T     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2839                |                  |

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/825,790

Applicant(s)

TSAY ET AL.

Examiner

Thanh-Tam T. Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, *"the connector and a casing portion adjacent to the connector form a first size and the slot connector and a casing portion adjacent to the slot connector define a space of a second size and the first size is greater than the second size"* must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The disclosure is objected to because of the following informalities:

Page 4, lines 7, 9 and 16 and page 6, lines 2-3, "circuit board 13" should be changed to -- circuit board 2 --.

Appropriate correction is required.

***Claim Objections***

4. Claims 1-5 are objected to because of the following informalities:

Claim 1, line 7, "the other end" should be changed to -- other end --.

Lines 12 and 13, "casing portion" should be changed to -- a casing portion --

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Shieh (6,122,175).

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Shieh, figures 2 and 3, discloses a converter for interface card, comprising a casing (10) and a circuit board (40) being encapsulated by the casing, wherein the circuit board comprising:

- a connector (20) at one end to be connected to a connector set of a first interface protocol provided in a computer (1);
- a slot connector (30) at another end to be connected by a connector of a second interface protocol of an interface card (3); and
- wires and electronic components to provide exchange of signals and electricity between a plurality of pins of the connector and a plurality of pins of the slot connector;

wherein the connector and a casing portion adjacent to the connector form a first size and the slot connector and a casing portion adjacent to the slot connector define a space of a second size.

Regarding claim 2, the first size is smaller than the second size.

Regarding claim 4 and 5, the first/second size is size of an Express Card standard connector and the second/first size is size to accept connector of a Card Bus standard interface card.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Georgopoulos et al. (5,457,601).

Georgopoulos et al., figure 3, disclose a converter for interface card, comprising a casing (302 and 304) and a circuit board (103) being encapsulated by the casing, wherein the circuit board comprising:

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- a connector (306) at one end to be connected to a connector socket of a first interface protocol provided in a computer;
- a slot connector (314) at another end to be connected by a connector of a second interface protocol of an interface card (110); and
- wires and electronic components to provide exchange of signals and electricity between a plurality of pins of the connector and a plurality of pins of the slot connector;

wherein the connector and a casing portion adjacent to the connector form a first size and the slot connector and a casing portion adjacent to the slot connector define a space of a second size.

Regarding claim 3, the first size is greater than the second size.

### ***Conclusion***


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh-Tam T. Le whose telephone number is 571-272-2094. The examiner can normally be reached on 7:30-5:00.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TC Patel can be reached on 571-272-2098. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TL.  
8/18/04.

  
T. Le